Supreme Court, U.S.
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No. 05-051162

In The

Supreme Court of the United States

CHARTER COMMUNICATIONS, INC.,

Petitioner,

v.

BROADCAST INNOVATION, L.L.C.,
IO RESEARCH PTY LTD.,

Respondents.

On Petition For Writ Of Certiorari To The United States Court Of Appeals For The Federal Circuit

PETITION FOR A WRIT OF CERTIORARI

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QUESTIONS PRESENTED

1. Whether the court of appeals erred in holding, contrary to the Second, Seventh and Ninth Circuits and its own predecessor court, that a patent is entitled to the priority date of an earlier-filed application, and thus is valid, despite the failure of the patent application to include a "specific reference" to the earlier-filed application as plainly mandated by 35 U.S.C. § 120.

2. Whether the court of appeals erred in failing to defer, contrary to this Court's governing administrative deference jurisprudence, to a U.S. Patent and Trademark Office regulation, 37 C.F.R. § 1.78, which expressly requires that a patent applicant seeking the priority date of an earlier international application must include, in the first sentence of its specification, a reference to the earlier application by international application number and international filing date, and indicate the relationship of the applications.

RULE 29.6 CORPORATE DISCLOSURE STATEMENT

Petitioner Charter Communications, Inc. has no parent corporation and no publicly held corporation owns 10% or more of its stock.

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PETITION FOR A WRIT OF CERTIORARI

Charter Communications, Inc. respectfully petitions for a writ of *certiorari* to review the judgment of the United States Court of Appeals for the Federal Circuit.

OPINIONS BELOW

The opinion of the Federal Circuit (App., *infra*, 1a-9a) is reported at 420 F.3d 1364 (Fed. Cir. 2005). The opinion of the district court granting petitioner's motion for summary judgment (App., *infra*, 10a-35a) is unreported.

JURISDICTION

The court of appeals entered its judgment on August 19, 2005. A petition for rehearing and rehearing *en banc* was denied on November 8, 2005. The Chief Justice, on January 25, 2006, granted an extension of time for filing a petition for a writ of *certiorari* to and including March 8, 2006. This Court's jurisdiction is invoked under 28 U.S.C. § 1254(1).

STATUTORY AND REGULATORY PROVISIONS INVOLVED

Section 120 of Title 35 of the United States Code as currently codified is reproduced in the appendix to this brief at App., *infra*, 52a, and as codified in 1999 at App., *infra*, 53a. Section 1.78 (2005 and 1999) of Title 37 of the Code of Federal Regulations is reproduced in relevant part in the appendix to this brief at App., *infra*, 53a-55a.

INTRODUCTION

This case presents two important legal questions regarding the construction of the Patent Act of 1952 and the PTO's regulations.

First, the Federal Circuit, in conflict with the precedents of multiple courts of appeals and of its predecessor court, ruled that an inventor, who files for a

patent asserting a priority date based upon the filing date of an earlier-filed application, need not cite to the actual earlier-filed application upon which the inventor relies for the patent's validity. The court of appeals reached this conclusion despite a statutory requirement, 35 U.S.C. § 120, that the inventor include a "specific reference" to that earlier-filed application to which he claims priority. Thus, the decision below can lead only to uncertainty, because the public can no longer determine from the face of an application, without the aid of any extrinsic material, the earlier application to which the new application claims priority. Instead, it becomes the burden and obligation of the public to search through multiple records of the PTO to determine the earliest possible application upon which the inventor bases priority, even though the applicant can easily disclose that information in the application.

Second, the Federal Circuit's ruling is contrary to the PTO's duly promulgated notice-and-comment regulation which has existed for nearly 60 years, 37 C.F.R. § 1.78(a)(2)(i). That regulation requires that a specific reference, to each earlier application to which the later application seeks priority, must be included in the first sentence of the later application's specification. The earlier-filed applications must be identified by application number, or, for international applications, by application number and international filing date, and the relationship of the applications must be indicated. The court of appeals rejected these regulatory requirements and the well-established law of this Court with respect to deference in judicial review of agency regulations. As this Court has made plain, a regulation can possess the force of law and merely the power to persuade, but courts are not empowered to disregard wholesale the agency's position even if it is entitled to lesser deference. Review here is critical because the Federal Circuit's effective invalidation of the PTO's regulation is part of a continuing pattern and practice of inconsistent degrees of deference conferred by the Federal Circuit to the PTO.

The implications of this case are far reaching and will have a profound effect on patent law and, by implication, innovation. The Federal Circuit's decision fundamentally shifts the burden to the public, rather than the applicant, to review a patent to determine the earliest filing date to which it claims priority. The earliest filing date a patent claims is of substantial import to the public, including other inventors and licensees, because it helps determine a patent's validity and the term of the patent, including its expiration date. Prior to the court of appeals' ruling, the earliest application whose filing date a patent could claim was *required*, by statute, to be identified in the application and, by regulation, to be printed in the first sentence of the specification. And, with respect to a patent based upon an earlier-filed international application, the inventor was required to disclose the international filing date. The Federal Circuit's ruling, in conflict with the other courts of appeals that have considered this issue, now obviates these requirements and their benefits to the public. This case presents a particularly good opportunity for the Court's resolution of the issue because the petition does not involve any issues of claim construction or examination of technology regarding the underlying patent. This Court should grant review to resolve the conflict of authority and the confusion concerning the proper deference to be accorded the PTO's regulations.

STATEMENT OF THE CASE

1. The Statutory And Regulatory Framework

a. Congress has authorized the PTO to grant a patent to anyone who "invents or discovers any new and useful process, machine, manufacture, or composition of matter, or * * * improvements thereof." 35 U.S.C. § 101. A patent affords the inventor "the right to exclude others from making, using, offering for sale, or selling the invention throughout the United States" for a limited period, currently set at 20 years from the time of the application filing date. 35 U.S.C. § 154(a)(2).